

REMARKS

Thorough examination of the application is sincerely appreciated.

Applicant's claims were replaced to remove European-type phraseology and address various formalities, as well as clarify and particularly point out the patentable subject matter of the present invention.

It is respectfully submitted that the rejections in the Office Action are confusing. For example, it is not understood what is meant by "Claims 1, 4, 6 and 8 **relative to Claim 1**" (emphasis added). Clarification is respectfully requested.

Furthermore, claims 1, 4, 6, and 8 were rejected in paragraph 5, page 3 of the Office Action. However, according to page 5 of the Office Action, claims 2 and 8 (again) are rejected. Furthermore, according to page 5 (bottom) of the Office Action, claims 3, 7 and Claim 8 (yet again) are rejected. Still further, according to page 8 of the Office Action, claim 8 is yet again rejected. Clarification is respectfully requested. Applicant's response is based on the best effort to understand the grouping of rejections in the Office Action.

According to the Office Action (as understood), claims 1, 4, 6 and 8 were rejected under 35 USC 103(a) as being obvious over PCT Publication WO 00/01154 (hereinafter "Rajan") in view of US Patent 6,563,515 (hereinafter "Reynolds"). Further according to the Office Action, claim 2 was rejected under 35 USC 103(a) as being obvious over Rajan in view of Reynolds and further in view of US Published Application US 2005/0193337 (hereinafter "Noguchi"). Still further according to the Office Action, claims 3 and 7 were rejected under 35 USC 103(a) as being obvious over Rajan in view of Reynolds and further in view of US Patent 6,941,574 (hereinafter "Broadwin"). Further to the Office Action, claim 5 was rejected under 35 USC 103(a) as being obvious over Rajan in view of Reynolds and further in view of US Patent

6,425,129 (hereinafter “Sciammarella”). Further according to the Office Action, claim 8 was rejected under 35 USC 103(a) as being obvious over Rajan in view of Reynolds, further in view Noguchi, and still further in view of Broadwin.

In response, the rejections are respectfully traversed as 1) lacking sufficient factual support, and 2) failing to establish a prima facie case of obviousness in accordance with the established case and statutory law.

Referring to pages 3 and 4 of the Office Action, it is conceded that Rajan, among other things, fails to disclose a number of features as now recited in Applicant’s claim 9. The examiner points to Reynolds for the alleged disclosure to cure the deficiencies in Rajan. Applicant’s representative has carefully reviewed the Reynolds patent and failed to find such a disclosure in the patent, contrary to the examiner’s remarks.

It is respectfully submitted that the examiner is factually wrong in relying on Reynolds to supplement Rajan. The examiner relies on Fig. 6a of the Reynolds patent. Nowhere in that figure or anywhere else in the patent does Reynolds show or teach, among other things, Applicant’s feature of “generating a second set of video objects based on the decoded video data, each of the video objects in the second set being generated by associating the decoded video data with properties for defining characteristics of said decoded video data in the MPEG-4 compliant video scene; and jointly rendering the first set and the second set of video objects” as recited in Applicant’s claim 9. Reynolds merely teaches the area occupied by the current channel reduced to accommodate both the program guide display and the program guide video window. Clearly, Reynolds is completely silent on, for example, associating the decoded video data with properties for defining characteristics of said decoded video data in the MPEG-4 compliant video scene, as recited in Applicant’s claim 9. If the examiner believes otherwise, he is respectfully

requested 1) to specifically point out where such a disclosure can be found in Reynolds as the examiner fails to cite any text portions in the patent except Fig. 6a; 2) to provide an affidavit stating facts within his personal knowledge; or 3) to provide a prior art reference stating the same, because the examiner's interpretation of Reynolds can't be supported by the record.

Furthermore, it is unclear whether the examiner relies on personal knowledge of the facts or those of a skilled artisan in his statement. If this is the case, then "particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." In re Kotzab, 1371.

The MPEP provides guidelines for relying on official notice and personal knowledge, which the Examiner did not follow in this case:

The rationale supporting an obviousness rejection may be based on common knowledge in the art of "well-known" prior art. The examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art ...

When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. Such an affidavit is subject to contradiction or explanation by the affidavits of the applicant and other persons.

See MPEP §2144.03. If the rejection is maintained, it is respectfully requested that the examiner provide an affidavit stating facts within his personal knowledge or an affidavit by a skilled artisan.

It is respectfully submitted that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify

the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143-§2143.03 for decisions pertinent to each of these criteria.

Analyzing the references according to the above roadmap, first the examiner did not offer any motivation or suggestion to modify or combine Rajan and Reynolds except for unsupported, conclusory remark that "to provide a dual tuner set top box ... so that the viewer could see video from two channels as opposed just one." It is not clear what the basis was for such a statement. In contrast to the remarks in the Office Action, Rajan is directed to "a method and apparatus for composing and presenting multimedia video programs using the MPEG-4 (Motion Picture Experts Group) standard" and Reynolds is directed to "to television program guides that support a video window function which may be used when browsing for available television programs." There is no motivation or suggestion to combine the references as Reynolds is completely silent on MPEG-4.

Second, there is no reasonable expectation of success because the prior art references are not combinable, and they do not supplement each other.

Third, Rajan and Reynolds, even when combined, do not teach Applicant's feature of "generating a second set of video objects based on the decoded video data, each of the video objects in the second set being generated by associating the decoded video data with properties for defining characteristics of said decoded video data in the MPEG-4 compliant video scene; and jointly rendering the first set and the second set of video objects," as recited in claim 9 and

discussed above. As argued above, the Applicant's features are not taught or suggested in the prior art references, and their combination is deficient in teaching or suggesting all the claim limitations.

Therefore, the cited references fail to render obvious the claimed invention, because the above-identified criteria are not met. The claimed invention, according to claim 9, is thus distinguishable over the cited references.

Independent claims 12 and 15 contain, among other things, the features of claim 9 as discussed above. Applicant essentially repeats the same argument as above and asserts that claims 12 and 15 are also allowable for the same reasons as claim 9.

Claims 10, 11, 13 and 14 depend from independent claims, which have been shown to be allowable over the prior art reference. Noguchi, Broadwin and Sciammarella are not relied upon in the Office Action to teach or suggest Applicant's features in claim 9. Hence, Noguchi, Broadwin and Sciammarella do not cure the deficiencies in Rajan and Reynolds. Accordingly, claims 10, 11, 13 and 14 are also allowable by virtue of their dependency, as well as the additional subject matter recited therein. Applicant submits that the reason for the rejection of claims 10, 11, 13 and 14 has been overcome and respectfully requests withdrawal of the rejection and allowance of the claims.

In view of the above, it is respectfully submitted that Rajan, Reynolds, Noguchi, Broadwin and Sciammarella, whether alone or in combination, do not anticipate or render obvious the present invention.

An earnest effort has been made to be fully responsive to the Examiner's correspondence and advance the prosecution of this case. If there are any questions, the Examiner is respectfully requested to call the undersigned attorney at the number listed below.

Please charge any additional fees associated with this application to Deposit Account No.
14-1270.

Respectfully submitted,

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